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EXAMINER

HENDERSON, MARK T

ART UNIT PAPER NUMBER

3722

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/016,508

Applicant(s)

BERMUDEZ, MIGUEL N.

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-5, 7, 8, 19 and 21-38 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1, 3-5, 7, 8, 19, 21-38 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

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DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9306. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 19 and 33 have been amended for further examination.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1, 19, 27 and 33 are finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

2. In regards to Claims 1, 19, 27, and 33 it is not understood what is meant by “uniquely identifies”. Applicant must disclose how this method of identifying is “unique” from any other identifying method.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 1, 3-5, and 19, 21-24 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Laurash et al (5,704,650) in view of Kelly, Jr and Blankenship et al and further in view of Christopher et al (5,227,617).

Laurash et al discloses in Fig. 1, 4 and 5, an article comprising: first identification label (26) and second identification label (29), and a base label (20, as seen in Fig. 2); wherein each

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identification label has a printed indicied identifier (56, as stated in Col. 7, lines 10-15, which can be in a combination of human readable and machine readable form; and wherein the first and second identification labels are removably fixed from an object's surface (Col. 7, lines 57-63, which can be a container) and attached to any other desirable surface (Col. 8, lines 1-5, which can be a device).

However, Laurash et al does not disclose: an object being a component container; an identifier that identifies a component inside the component container; and wherein the identifier indicia being electronically stored in the component and being read from the component and printed on the labels.

Kelly, Jr. discloses an object being a component container (24) having components (20) and a device (contents inside component box (20)), wherein a label (30) is removably affixed to the component container, and has an identifier (bar code 42) that uniquely identifies the component inside the container.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Laurash et al's label to include a label having an identifier which identifies the components inside of a container, as taught by Kelly, Jr. for the purpose of keeping an inventory record.

However, Laurash et al as modified by Kelly, Jr. does not disclose: wherein the identifier is electronically stored in the component and read from the component and printed on the labels.

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Blankenship et al discloses in Fig. 1-5, an identifier which can be electronically stored on a component (in this case encoding by imprinting magnetic impulses on a wire), and read (by using the Hall effect), and placed as a bar code on an adhesive label (Col. 3, lines 3-33), and wherein the adhesive label is placed on any desirable surface such as a container (reel or barrel for holding wire).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Laurash et al's article with an identifier that is electronically stored in a component as taught by Blankenship et al for the purpose of providing an identification means having greater security.

However, Laurash et al as modified by Kelly, Jr and Blankenship et al does not disclose: wherein the identifier is read and printed on labels.

Christopher et al discloses in Col. 3, lines 60-68, and Col. 4, lines 1-4, an identifier (code printed on scanned records) which is read and in turn prints desired information associated with the identifier on a label (by a scanner/ labeler, 10).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Laurash et al's, Kelly's and Blankenship et al's article with an identifier which can be read and be printed out on labels through the use of a scanner/labeler as taught by Christopher et al for the purpose of accurately identifying the component and eliminating human error that may result form improper identification of the component.

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In regards to **Claims 3, 4, 21 and 22**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the first and second label at any desirable location, since it has been held that rearranging parts of an invention involves only routine skill in the art. Applicant has not disclosed the location of the labels is critical to his invention, and the invention would work equally as well with the labels in an alternative position.

4. Claims 7, 8, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over in Laurash et al as modified by Kelly, Jr, Blankenship et al and Christopher et al, and further in view of Brower et al (6,348,685).

Laurash et al as modified by Kelly, Blankenship et al and Christopher et al discloses an article comprising all the elements as disclosed in Claims 1 and 19, and as set forth above.

However, Laurash et al, Kelly and Blankenship et al do not disclose: wherein the container object is constructed of polyester and is a electrostatic discharge bag.

Brower et al discloses in Fig. 9, an polymeric material (polyester) electrostatic discharge bag (14) container object.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Laurash et al's object with an electrostatic bag object as taught by Brower et al for the purpose of holding electronic equipment.

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Allowable Subject Matter

5. Claims 27 and 33 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

6. Claims 28-32 and 34-38 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

7. Applicant's arguments filed on August 18, 2003, have been fully considered but they are not persuasive.

In regards to Applicant's argument that the definiteness of the phrase "uniquely identifies" must "be analyzed in light of the content of the specification" and the "uniquely identifies means that the identifier distinguishes one component from any other component", the examiner submits that it is noted that the feature upon which applicant relies (i.e., identifier distinguishes one component from any other component) is not recited in the rejected claim(s). Although the claims

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are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In regards to applicant's argument and amendment that the Christopher reference does not disclose an "identifier electronically stored in the component and read therefrom", the examiner submits that the Laurash et al as modified by Kelly and Blankenship et al references are relied upon for further disclosing these limitations. Christopher et al is only used for disclosing an identifier which is read and in turn prints out desired information. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Laurash et al's, Kelly's and Blankenship et al's article with an identifier which can be read and be printed out on labels through the use of a scanner/labeler as taught by Christopher et al for the purpose of accurately identifying the component and eliminating human error that may result from improper identification of the component.

Therefore, the rejection have been maintained.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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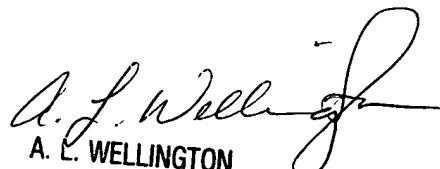
Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (571)272-4477. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (571) 272-4483. The fax number for TC 3700 is (703)-872-9306.



MTH

December 5, 2004



A. L. WELLINGTON
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